

REMARKS

Status of the Claims

Claims 1-3, 8-13, 19, 20, 29-31 and 39-61 are in the application.

Claims 1-3, 8-13, 19, 20, 29-31, 39, 41, 42, 44, 45, 47-51, 53-58 and 61 were rejected.

Claims 40, 43, 46, 52 and 59 have each been objected to as being dependent on a rejected base claim.

Applicants respectfully request that claims 1, 11 and 55 be amended and claims 40-45, 58 and 59 be canceled

Upon entry of this amendment, claims 1-3, 8-13, 19, 20, 29-31, 39, 46-57, 60 and 61 will be pending.

Summary of the Amendment

Applicants request that claims 1, 11 and 55 be amended to incorporate the limitations of claims 40, 43 and 59, respectively. Upon entry of such amendment, the scope of claims 1, 11 and 55 now correspond to the previous scope of claims 40, 43 and 59, respectively. No new matter is added.

Applicants request that claims 40, 43 and 59, be canceled in view of the amendment of claim 1. 10 and 55.

Applicants request that claims 41, 42, 44, 45 and 59 be canceled without prejudice.

Claim Rejection Under 35 U.S.C. § 103

Claims 1-3, 8-13, 19, 20, 29-31, 39, 49 50, 53-57, 60 and 61 stand rejected under 35 U.S.C. § 103 as being unpatentable over Silberg in view of US Patent No. 5,601,990.

Claims 41, 44, 47, 51 and 58 stand rejected under 35 U.S.C. § 103 as being unpatentable over Silberg in view of US Patent No. 5,601,990 and further in view of Genbank Accession no. U51095.

Claims 42, 45, 48, 51 and 58 stand rejected under 35 U.S.C. § 103 as being unpatentable over Silberg in view of US Patent No. 5,601,990 and further in view of Genbank Accession no. U15212.

In response to Applicants' previous arguments, the Office states that "Silberg teaches a possibility of CDX1 expression being a marker" and that

[t]he instant claims as drafted say the presence of
CDX1 expression indicates a possibility of
metastatic colon gastric or esophageal cancer.

The scope of each of claims 1-3, 8-13, 19, 20, 55-57, 60 and 61 each now recite the limitation of either claim 40, 43 or 59, which are not rejected. Accordingly, the rejection as applied to claims 1-3, 8-13, 19, 20, 55-57, 60 and 61 is moot. Claims 41, 42, 44, 45 and 58 are canceled and the rejection of them is therefore also moot.

Claims 29-31, 39, 47-51, 53, 54, and 61 remain pending with their prior scope. Applicants respectfully urge that the subject matter of these claims is not obvious in view of Silberg, the 990 patent and Genbank accession nos. U51095 and U15212.

As noted above, the Office urges that Silberg teaches a possibility of CDX1 expression being a marker" and the instant claims refer to the presence of CDX1 expression as indicating a possibility of metastatic colon gastric or esophageal cancer.

Claims 29-31, 39, 47-51, 53, 54, and 61 do not refer to the presence of CDX1 expression as indicating a possibility of metastatic colon gastric or esophageal cancer. Rather claims 29-31, 39, 47 and 48 refer to methods of diagnosing metastatic esophageal cancer. Claims 49-51, 53 and 54 refer to methods of diagnosing metastatic colorectal cancer. These claims provide diagnoses rather than screening for the possibility of a disease. Accordingly, the basis for rejecting the claims does not apply to claims 29-31, 39, 47-51, 53 and 54.

Applicants respectfully request that the rejections of claims 1-3, 8-13, 19, 20, 29-31, 39, 47-51, 53 and 54-57, 60 and 61 be withdrawn.

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Claims 40, 43, 46, 52 and 59 have been objected to as being dependent on rejected claims. The subject matter of claims 40, 43 and 59 has been incorporated into independent claims 1, 11 and 55, respectively, from which the claims previously depended and claims 40, 43 and 59 have been canceled. Accordingly, as amended, claims 1, 11 and 55 are allowable. Further, claims 2, 3 and 8-10, which are dependent on claim 1, claims 12, 13, 19 and 20 which are dependent on claim 11, and claims 56, 57, 60 and 61, which are dependent on claim 55, are also allowable.

Conclusion

Upon entry of this amendment, claims 1-3, 8-13, 19, 20, 29-31, 39, 46-57, 60 and 61 will be in condition for allowance, or in better condition for appeal. Entry of this amendment is respectfully requested. A notice of allowance is earnestly solicited. Applicants invite the Examiner to contact the undersigned at 610.640.7820 to clarify any unresolved issues raised by this response.

The Commissioner is hereby authorized to charge any deficiencies of fees and credit of any overpayments to Deposit Account No. 50-0436.

Respectfully submitted,

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